BLANK PAGE

FILE COPY

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1940.

No. 9.

THE SCHRIBER-SCHROTH COMPANY,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.

No. 10.

THE ABERDEEN MOTOR SUPPLY COMPANY,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.

No. 11.

THE F. E. ROWE SALES CO.,
Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,
Respondents.

PETITIONERS' REPLY BRIEF.

JOHN H. BRUNINGA,
JOHN H. SUTHERLAND,
Attorneys for Petitioners.

October 19, 1940.

St. Louis Law Printing Co., 415 North Eighth Street. CEntral 4477.

BLANK PAGE

TABLE OF CONTENTS.

	Page
Point I	2
As to Exhibit 1	5
Point II	6
There is no evidence that the piston of the Jardine patent has the structure and mode of operation to secure the result put forward by respondent, namely, a "minute clearance," or a clearance of .002 inch	6
The Long commercial pistons were proved as having been in commercial use prior to March 11, 1920	10
1. Obsolescence	10
2. Clearance at .002 inch	11
3. Structure and mode of operation	12
Finally the Long commercial pistons had flexing webs	12
4. The Long patent did not have inflexible webs, and it does not so state	13
5. The Long commercial pistons were proved	15
There is even documentary evidence	16
6. This Court's decisions are determinative	17
Point III	22
The issue here has not become moot, but is still important so far as the public interest is concerned	26
Aluminum Company of America	28
"Patent pools"	28
"Sins of the past"	28
"'Smartness' of petitioners' brief"	30
The renouncement and denouncement of petitioners' now expired patents	30
Affidavit of Horace Duncan	33

Cases Cited.

Altoona Theatres v. Tri-Ergon, 294 U. S. 477, 489.... 4
Atlantic Works v. Brady, 107 U. S. 192..... 29
Berry v. Bohn Aluminum & Brass Corp., 29 F. Supp. 516, 517, 522 9
Camp v. Gress, 250 U. S. 308, 318..... 25
Cleveland Trust v. Berry, 99 F. (2d) 517..... 9
Crown Die & Tool Co. v. Nye Tool & Machine Works, 261 U. S. 24, 40..... 23
De Forest v. General Electric, 283 U. S. 664.....28, 30
Delk v. St. Louis & S. F. R. Co., 220 U. S. 580, 588.... 25
Downtown v. Yeager, 108 U. S. 466..... 29
Eames v. Andrews, 122 U. S. 40, 56.....18, 20
Eibel Co. v. Paper Co., 261 U. S., l. c. 53..... 16
Equitable Trust Co. v. Denver & R. G. R. Co. (C. C. A. 2), 250 F. 327, 340..... 23
Gayler v. Wilder, 51 U. S. 477, 497.....18, 29
Honolulu Oil Corporation v. Halliburton, 306 U. S. 550 14
Independent Wireless Telegraph Co. v. Radio Corporation of America, 269 U. S. 459, 464, 465..... 23.
Le Roy v. Tatum, 14 How. 156..... 28
Lovell Mfg. Co. v. Cary, 147 U. S. 628..... 3
Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 494 29
McCain v. Ortmayer, 141 U. S. 419, 428..... 29
McCarty v. Lehigh Valley, 160 U. S. 110..... 28
Milburn Co. v. Davis, 270 U. S. 390..... 14
Minerals v. Magna Copper, 280 U. S. 400..... 29
Permutit Co. v. Graver, 284 U. S. 52..... 28
Peters-Bates Case, 295 U. S. 392..... 22
Smith v. Hall, 301 U. S. 216..... 30
Smith v. Snow, 294 U. S. 1..... 30
Sterling Products Corp. v. Cleveland Trust, 94 F. (2) 1019 27

Thompson v. Boisselier, 114 U. S. 1 29
Twist v. Prairie Oil & Gas Co. (C. C. A. 8), 27 F. (2d) 470, 474 ..... 23, 24
Twist v. Prairie Oil & Gas Co., 274 U. S. 684, 692 23
Webb v. Portland Manufacturing Co., F. Cas. No. 17,322 25
White v. Dunbar, 119 U. S. 47 28

Statutes Cited.

R. S. 4886 ..... 21, 28, 29
R. S. 4888 ..... 4, 20, 21, 28
U. S. Code, Title 35, Sec. 67 (R. S. 4919) 23

BLANK PAGE

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1940.

No. 9.

THE SCHRIBER-SCHROTH COMPANY,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 10.

THE ABERDEEN MOTOR SUPPLY COMPANY,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

No. 11.

THE F. E. ROWE SALES CO.,

Petitioner,

vs.

THE CLEVELAND TRUST COMPANY,
CHRYSLER CORPORATION,

Respondents.

PETITIONERS' REPLY BRIEF.

Respondent's brief is divided into a number of parts: the first part, pages 1-26, discusses the question of whether the issue has now become moot, the Aluminum Company of America and the patent pool, and, finally, what Respondent's counsel denominates "The Sins of The Past";

the second part, pages 27-34, is concerned with what Respondent's counsel denominates the "'Smartness' of Petitioners' Brief"; the third part, pages 35-88, discusses points I, II and III; and the fourth part, pages 89-101, again discusses the Jardine patent and the prior art, previously discussed in the second part.

We will first answer the second part under the Points noted in Petitioners' brief. We will not dwell at length upon the remaining parts of Respondent's brief, except to the extent absolutely necessary to assist this Court.

POINT I.

This is covered by Petitioners' brief, pages 29-44, and by Respondent's brief, pages 35-53. We shall treat the subject under the same designations as in Respondent's brief:

(a) The statement (Respondent's brief, p. 35) that the Court of Appeals did not treat "flexing webs" as essential elements of the Jardine patent is contrary to what Respondent's counsel said on the preceding page 24 of that same brief, namely,

> "... it has been determined as a part of the law of this case that the flexible web or web flexibility is an **essential** feature and **element** of the combination..."

Of course, at page 24 Respondent's counsel were discussing the prior art, while at page 35 the scope of the patent was discussed. Respondent's counsel evidently overlooked the fundamental rule of patent law, and indeed of common sense, that the scope of a patent when patent-

---

Note. The references are to pages of the Record as they appeared in the Court of Appeals. Emphasis in quoted parts is ours.

ability is being considered must be consistent with scope of the patent when infringement is in question.*

The question here is not simply one of whether a claim should be construed in connection with the specification, so that counsel's elaborate discussion of that phase and the analogies to contract law were unnecessary; the question is more narrow, as noted in Petitioner's brief, pages 29 and 41. Furthermore, the distinction between an element and a characteristic of an element is simply hair-splitting, and was discussed in Petitioner's brief, page 33. Indeed, the second decision of the Court of Appeals made no distinction when the Court, in discussing the Gulick and Maynard patents, said, page 4:

> ". . . it seems immaterial whether we read an element into them or merely construed an existing element as having in its environment a given characteristic."

The treatment by Respondent's counsel of Scaife v. Falls City (brief, page 41), seeks to make a distinction between a situation where this "peculiar form" of an element is in one claim of a patent and not in another claim, and a situation where it was originally in a claim and then taken out, after adverse decisions in interferences, as happened during the prosecution of the Jardine application. There is no distinction at all, and, besides, here counsel insist that flexibility should be read into the claims of the Jardine patent.

(b) Respondent's counsel state (brief, p. 42) that

"The omission of the word 'flexible' from the Jar-

* "In the testimony for the plaintiffs it appears to be contended that, in order to establish the charge of infringement, the patent is to be construed so as to cover the restoring of strained steel springs by the application of any temperature, less than a red heat, which will produce in the metal a blue color. If that be true, the patent must be so construed also in comparing it with the prior state of the art" (Lovell Mfg. Co. v. Cary, 147 U. S. 628).

> dine claims may have been deliberate and intentional without making the rule of construction inapplicable."

No decision was cited for the support of such a bold statement. The contract analogy cannot apply, because **R. S. 4888 requires two things, namely, a description and claims;** and it is the claims that define what is covered by the patent. Surely, when a limitation has been deliberately taken out of a claim, after an adverse decision in an interference, it cannot thereafter be put back by construction. This Court would not even permit a broad element, "means," to be restricted by a specific one, "a fly-wheel" (i. e., a rotating means), in Altoona Theatres v. Tri-Ergon, 294 U. S. 477, 489, cited in Petitioners' brief, page 33.

(c) Respondent's brief, page 43, makes the bold statement that "no such claims were added" by amendment by Jardine, including "flexible webs." Petitioners' brief, page 7, cited chapter and verse, and reference thereto will be sufficient. There can be no distinction because the Jardine claims are combination claims, for, likewise were those added by amendment, lost in interferences, and canceled.

(d) In Respondent's brief, page 45, we find a statement, as follows:

> "Upon the basis of this heresy it is claimed that the Court of Appeals considered that flexing webs was a distinguishing feature of Jardine and that it is necessary to read the flexing webs into the claims to avoid the prior art."

We invited the Court's attention at the beginning of this discussion to the quotation from page 24 of Respondent's brief. Statements, similar to the above, are found on pages 46 and 51; but it now appears that what Respondent attempts to do is secure a broader construction of the claims than those including flexing webs, to say nothing of

> ". . . the bending or flexing of straight ribs so pro-

> portioned as to yield to the thermal expansion of the bosses on the cantilever principle . . .",

which the Court of Appeals found it necessary to import into the Jardine claims in order to hold them valid over the Hartog patent (2d Dec., p. 8). However, in seeking to further distinguish from Hartog (brief page 52), counsel state as to Hartog's webs:

> ". . . they would not flex or bend **in the sense** in which the Jardine webs do to contribute to the solution of the aluminum piston problem",

although the previous argument was that the Jardine claims would not have to be construed to have flexible webs. But if Jardine's webs had to flex or bend in some specific way ("sense"), then counsel has confused the Jardine claims still further, by considering the Jardine webs "like a nose of wax which may be turned and twisted in any direction." (See White v. Dunbar, Petitioner's brief, page 31.)

As to Exhibit 1,* Respondent's brief, page 53, states that

> "The Exhibit 1 webs are flexible, and the only difference between the Exhibit 1 webs and the Jardine webs in that respect is a matter of degree of flexibility."

Counsel then quote Mr. Stellmann, who gave a direct answer to a direct general question, as counsel do when they say in their brief (p. 78) "a crowbar is flexible." Counsel do not quote the next question and answer, which are as follows (R. 581):

> "Q. Well, the webs 25 of the Jardine patent are described as flexible. **Do you find flexible webs** at the top in Exhibit 1? **A. No**; and Exhibit 1 is stiffer at the top than the Jardine."

Of the other record pages cited, R. 530 has reference to

*See Illustration, Petitioner's Brief, p. 26.

the Gulick patent; R. 593-5 has reference to a test by Jeffries of Exhibit 1 with the skirt detached from the head, and in which, of course, the skirt and not the webs flexed. However, Jeffries testified with reference to Exhibit 1 with the Keystone relief (R. 955) as follows:

> "The turning in of the webs at their outer ends in Plaintiffs' Exhibit 1 makes them more flexible in the thrust direction than the webs shown in the Maynard patent."

Such a construction, however, results in a web, which is **curved and not straight**, and therefore "of a resiliency in **arcuate extensions**," which the Court of Appeals found in the **Hartog patent** and distinguished from by assigning to **Jardine "straight ribs** so proportioned as to yield . . . on the **cantilever principle**" (2d Dec., p. 8). Respondent's counsel have not answered the discussion on Exhibit 1 in Petitioners' brief, pages 25-27 and 41-44.

POINT II.

This point was discussed in Petitioners' brief, pages 44-57, and in Respondent's brief, pages 54-84.

There Is No Evidence That the Piston of the Jardine Patent Has the Structure and Mode of Operation to Secure the Result Put Forward by Respondent, Namely, a "Minute Clearance," or a Clearance of .002 Inch.

The theme of Respondent's brief is that the piston of the Jardine patent has a structure and a mode of operation to secure a definite result, namely, a **"minute clearance,"** which is specified as a clearance of **.002 inch,*** and even **.001 inch,**** the ".002 or less" being the figure given

*Respondent's brief, pp. 21, 22, 23, 28, 33, 54, 55, 58, 65, 67, 72, 78, 81, 85, 92 and 99.

**Respondent's brief, pp. 26, 27.

by the Court of Appeals in its second decision (p. 8). Respondent's counsel (brief, p. 26) states:

> "It is important to remember that he was required to produce a piston in which there was to be, and to be roughly no more than, **one-thousandth** of an inch clearance between the piston and the cylinder. . . ."

Further (p. 27):

> "There is not a scintilla of evidence anywhere in this Record supporting a contention that any of the prior art devices could operate at this narrow clearance.† . . . None of them was capable of operating at the required one-thousandth inch clearance."

This is stated to be (p. 27 and repeated at p. 55) a

> "*sine qua non* of the solution of the problem."‡

It is stated (Res. Br. 65) that the Long piston was used only experimentally at a clearance of .002 inch and that the commercial use was at ".004 or .005 clearance."* In the concluding part of Respondent's brief (p. 89) it is stated,

> "Of course, if the solution of the aluminum piston problem and the sustaining of patent protection on the invention that solved that problem now rates as 'sins of the past,' that is an end of this litigation for, manifestly, we have no case on that basis."

It is self-evident, therefore, that if the sine qua non of Jardine's alleged invention, namely, the capability to operate at a clearance of .002 inch or less, and which is the

---

†Such denial is made with reference to the prior art generally in Respondent's brief, p. 21; with reference to Hartog and Pomeroy, p. 25; Long, pp. 54, 55, 58, 65, 67, 72, 78, 81 and 85, and Franquist, p. 99.

‡We find further in Respondent's brief such statements as (p. 72) "the necessary clearance of .002," and (p. 78) "the necessary clearance"; also (p. 81) "the desired clearance" and (p. 92) Jardine's "achievement."

*We have shown (Petitioners' brief, p. 23) that as early as 1920 the Long pistons were given a clearance of .002 inch when they went into production in the Franklin air-cooled engine (it is so stated in Franklin's Bulletin, R. 1587); but that later, when the compression and power increased, the clearance was increased from .004 inch to .005 inch.

mainstay of Respondent's brief, has no basis in the evidence, then, obviously, Respondent has "no case on that basis," **Respondent offered no evidence of commercial success of the Jardine piston at all** (see Petitioners' brief, pp. 24 and 27) and although Respondent's brief (p. 29) has a subchapter entitled, "Public Adoption and Commercial Use of Jardine," we find no evidence there. Respondent there relies upon Jeffries' testimony on prima facie which, he admitted on cross-examination, was based upon hearsay (R. 1045). Even the hearsay claim of supposed commercial success was based upon the piston of the Maynard patent* (R. 462, 471) and not on the Jardine piston. Respondent's witness Jeffries admitted that not a single Jardine piston has been sold and that the Jardine piston was subject to oil-pumping (R. 145). Not a single test of a Jardine piston was exemplified by any report, but Respondent contented itself with Jeffries' statement on cross-examination (R. 145):

> "It was proved in, however, and was about ready to be placed on the market when the Maynard Piston was brought forth . . . ."

Although that statement of Jeffries is not evidence, it must be taken with care, because of a similar statement that Exhibit 1 without the Keystone relief had been on the market, which was later on shown (Petitioners' brief, p. 27) to be based upon hearsay and refuted on cross-examination.

The assertion in Respondent's brief (p. 93):

> "In other words, he made the piston flexible enough to prevent the sticking and the seizing and at the same time made it possible to prevent the **oil pumping,**"

is contrary to the evidence because Jeffries admits (R. p. 145) that the Jardine piston was subject to oil pumping.

*Held invalid by the Court of Appeals.

The "invar strut" piston is now put forward in Respondent's brief (p. 29) as a "public adoption and commercial use of Jardine." Later, on page 56, it is stated that the Long piston "was driven out by the pistons involving the Jardine invention"; the references (R. 141, 176) are to the Ray Day piston held non-infringing, by the Court of Appeals in its second decision (p. 9). The reference (R. 187) is to "an attempt to commercialize the Jardine piston."

The reference (R. 672) is to the invar strut piston. This is Exhibit AAA, Plaintiffs' Exhibit 41, about which very little was said, being merely identified by Jeffries. A mere examination of that piston will show that any contention that Exhibit AAA comes within the Jardine patent is absurd. The piston is **not an all aluminum piston**, but is of a type having **steel struts**, of a lower coefficient of expansion than aluminum, so as to approximate the expansion characteristics and even be less, than the iron of the cylinder, so that **flexing is obviously unnecessary and not present.*** The principle of this strut piston is so radically different from that of an all aluminum piston having flexing webs that the absurdity of Respondent's position is self-evident.

We do not even have a model of the Jardine piston before the Court because none was offered at the trial or exhibited to the Court of Appeals. Accordingly, all the talk about Jardine solving a problem, the achievements of Jardine and his being the first piston to operate at a .002 inch clearance, or less—the so-called sine qua non of the Jardine alleged invention—has no basis in the evidence whatsoever. Respondent therefore has "no case on that

*This piston in its various forms is described in Berry v. Bohn Aluminum & Brass Corp., 29 F. Supp. 516, 517, 522, Exhibit 302. It is interesting also to note that there was a question of priority between Jardine and Berry on the strut piston, which was decided against Jardine by the Circuit Court of Appeals for the Sixth Circuit (Cleveland Trust v. Berry, 99 F. [2d] 517).

basis," as Respondent's counsel admit (brief, p. 89) they must have in order to prevail.

The Long Commercial Pistons Were Proved as Having Been in Commercial Use Prior to March 11, 1920.

Petitioners' brief (pp. 17-25, 53, 55) discusses the evidence. Respondent's contention as to this Long piston, although scattered throughout Respondent's brief, we understand, is based upon the points:

1. That the Long piston became obsolete and therefore could not have been commercially successful;

2. That the Long piston did not operate commercially at a clearance of .002 inch, asserted as the *sine qua non* of the Jardine patent piston;

3. That the Long piston did not have the structure and mode of operation of the Jardine piston; and

4. That the Long patent disclosed inflexible webs;

5. That the Long pistons were not proved;

6. That this Court's decisions cited by Petitioners do not apply.

1. **Obsolescence.** The argument is amusing. The Master found (finding 37, R. 1102-3), as noted by this Court (305 U. S. 55) that the Long pistons "were in commercial use from 1917 on." According to Respondent's witness Castor, the Long pistons were used exclusively in the Franklin automobile from **1920 to 1929**, to a total of over **350,000** pistons, but that in 1929 compression in the Franklin was increased, and that the Long piston was then replaced, not by Exhibit 1, but by the invar strut piston (R. 672).* The

*We showed in Petitioners' brief, pages 24-5, that Long was literally driven out of the field by Respondent.

Jardine slipper piston never appeared on the market at all, and not even a model could be produced in Court—all as shown above. It was also shown in Petitioners' brief, page 27, that Exhibit 1 with the Keystone relief was actually the first proved use of Exhibit 1, which was not until at least February, 1925.** According to Respondent's brief (page 2), Exhibit 1 has "become obsolete since this suit was tried"—but let us call that 1940. We, therefore, have the Long piston as the first commercial split skirt aluminum piston in use from 1917 to 1925, and in continuous use from 1917 to 1929, a total of **twelve years.** Exhibit 1 had a life of **fifteen years.** The Jardine piston had no commercial life at all. We think that this answers the question of obsolescence of the Long piston as affecting its commercial utility.

2. **Clearance at .002 Inch.** As shown previously, there is no proof that any Jardine piston ever would or could operate at a clearance of .002 inch, because it never went into commercial use. There is no evidence that even Exhibit 1 without the Keystone relief operated in commercial use at a clearance of .002 inch or less or at any other clearance. As pointed out in Petitioners' brief (pages 23-4), the testimony of Respondent's witnesses shows that the Long piston at the beginning operated at .002 inch clearance; that in 1920 it operated at .002 to .003 inch clearance, but that in 1929 the clearance was increased to .005 inch, as against the invar strut (not all-aluminum) clearance in 1929 of .0025 to .003 inch. Surely, reliance cannot be had upon a piston whose clearance requirement was not proved

**The attempt of Respondent's counsel to set that date back to 1921 (Br. 34) must fail. Mr. Stellmann at the record page cited (462) was asked about a piston "like that shown in the drawing of the Maynard patent 1,655,968," and he said that his memory was "around 1921." On redirect (471) he was not certain whether it had a slot in it. Be that as it may, the Maynard patent piston could not be the Jardine patent piston and still be capable of patent protection because the Court of Appeals held the Maynard patent invalid as "not marking inventive steps over prior art" (2d Dec., p. 5).

so as to render ineffective as a statutory bar a piston whose clearance was proved. Surely a thing which never went into commercial use cannot be said to stand out against something which was in commercial use for twelve years.

3. **Structure and Mode of Operation.** We have shown under Point I how indefinite is Respondent's contention as to the structure and mode of operation of the Jardine piston. If by structure is meant a strictly slipper piston, then, of course, the Long piston was not a slipper piston, but neither is Exhibit 1, which the Court of Appeals in its first decision (p. 11) specifically said is not a slipper piston. A mere comparison of Exhibit 1 and the Long piston will show that Long retains the side supports at the bottom in the regions of the bosses, as does Exhibit 1. If the characteristic feature of the Jardine patent is what Jeffries said it was, or what the Court of Appeals said it was, then Exhibit 1 does not have the flexible webs of the Jardine piston, see Petitioners' brief (pages 42-3). This shows the tenuous and even weird procedure that Respondent follows in seeking to find validity on the one hand and infringement of the Jardine patent on the other hand.

Finally, the Long commercial pistons had flexing webs; more so than has Exhibit 1, even with the restrictions which the Court of Appeals read into the Jardine claims in order to distinguish them from Hartog. The attempt of Respondent's counsel to overcome the fatal admission of Respondent's witness Jardine, discussed in Petitioners' brief, pages 48-50, will not, it is believed, satisfy this Court. We feel confident that if this Court will read the cross-examination of Jeffries (R. 985-7 and 1007-9), preceding the fatal admission (R. 1009-10), and also the additional cross-examination (R. 1010-11)—all relating to Long pistons—this Court will come to the conclusion that

there was no "private contest for dominancy in a colloquy," as distinguished from "an effort to ascertain the true facts upon which justice can be reached," as charged in Respondent's brief, page 78. Indeed, such a contention is absurd with a witness as expert, astute, and sophisticated as was Dr. Jeffries, and with Respondent represented at the trial by no less than two able counsel, who did not fail to redirect Dr. Jeffries on matters where they thought their case had been damaged, provided the damage could have been repaired.

4. **The Long Patent Did Not Have Inflexible Webs, and It Does Not So State.** The Long patent, on which we need not rely for web flexibility because it was in Exhibit F, before Jardine filed, states the following (R. 1737-1738):

> ". . . when highly heated conditions exist the body portion of the piston comprised of the wrist pin sides 4 and separated portions 6 can expand without fitting too tightly against the cylinder wall, as the expansion thereof will be taken up by the slots 7 and 8, as **expanding and contracting resiliency** is given to the body portion 3 of the piston by the separated portions thereof."

The above statement certainly does not say that the webs are inflexible. Nor does the part quoted by Respondent's counsel (brief page 82) that

> "'Inasmuch as the separated **portions 6** will be rigidly held against bending against the forcing thrust of the piston from the connecting rod of the piston . . .'"

say that the webs 10, previously discussed, are rigid, because "**portions 6**" refers to the **skirt parts**, which lie circumferentially against the cylinder wall, and which, of course, hold the conforming skirt against bending.

In short, while the patent is silent on whether the webs of the Long patent are flexible, the specification certainly

does not say that they are inflexible, as did the Gulick application when filed.

Respondent's counsel, however, in that part of their brief discussed under Point I, in seeking to bolster up their contention that the Court of Appeals was warranted to read flexing webs into the claims of the Jardine patent, said, page 41:

> "They only interpreted structure already in the claims as having a certain property which the specification described it as having and which the merest tyro in the business would know that it did have whether it was in the specification or not."

That concession of Respondent's counsel should settle the matter of whether or not, to one skilled in the art, the Long patent disclosed a piston having flexible webs.

There is no inconsistency in Petitioners' position in this respect in Petitioners' brief, page 56, with the position taken by Petitioners before this Court, when the Gulick patent was involved, as charged in Respondent's brief (page 84). In the first place, the Gulick application was not one in which the specification was silent, but one in which the description in the specification was the very antithesis, namely, "an extremely rigid connection between the piston pin bosses and the skirt of the piston." Second, before Jardine filed, both Hartog and Pomeroy had already described flexible webs, so that one skilled in the art would naturally read Long's disclosure in his application* (filed March 7, 1919) as having flexible webs.** That was the basis of the argument in Petitioners' brief, pages 55-57.

---

*Note here that the disclosure in an issued patent is effective from its filing date (Milburn Co. v. Davis, 270 U. S. 390).

**In Honolulu Oil Corporation v. Halliburton, 306 U. S. 550, this court decided that the use of an old expedient "is necessarily implied from the language of the Franklin patent. Detailed description by Franklin was not necessary" (l. c. 559).

5. **The Long Commercial Pistons Were Proved.** The evidence is found in Petitioners' brief, pages 17-25, and argued, pages 53-55. Respondent's argument overlooks the positive evidence in this case, to say nothing of circumstantial evidence, in which the links of the chain fit together to make a whole. The three witnesses called by Respondent, primarily to rebut the existence of the Long piston prior to 1919, clearly prove such use, and even commercial use, in 1919; and Jeffries said he was familiar with the Long pistons in 1920 (R. 940).* We will not take up one by one the citations by Respondent's counsel, since that would unduly extend the brief, for the record, which has been reduced, is before this Court; but we will simply give a few examples of the hair-splitting and errors in Respondent's brief.

Reference to R. 666 will show that the Long pistons did not fail in 1919, but that the fault of "a test" was due to a faulty oiling system. Burns testified (R. 676) about an entirely different piston; but he said, as to the 1919 Long piston, Exhibit F (R. 690, 691):

> ". . . they didn't set up; **they were beautiful**, when this trip was completed, about 900 or 1,000 miles on them, this car was pulled down after I made the installation, and **they were all in fine shape. . . . That Long piston was the first piston that was quiet and would go out and do a real day's work.**"

Jeffries (R. 939) talked about a single piston, Exhibit F, and not as it appears on cross-examination (R. 1010), the Long pistons generally. Venner's testimony (R. 360) has reference to one of the first Long pistons, but in which there was trouble due to a faulty oiling system (R. 370).

*Note that there is no question as to what pistons Jeffries saw in 1920, for previously the Long pistons, Exhibits E and F, had been discussed (R. 939). Furthermore, in giving the 1920 date (R. 986), Long pistons Exhibits E and F were discussed and Jeffries says, "Yes, these were used."

Murphy's testimony (R. 656) has reference to a different piston, as also does the testimony at R. 1438, R. 1440-1, and R. 1443, while R. 1458 does not even relate to this subject. Chadwick (R. 380) testified about strengthening the head of the piston with three ribs rather than one rib, and not that that they fell apart. Jeffries' testimony (R. 1010-11) is about tales brought in by the automotive engineers of Aluminum Company. The quibbling about such matters as "type" not referring to a particular piston is puerile; the reference to Venner's testimony (R. 389) shows that Venner intended the word "type" to mean that "it was of the same construction." Of course the Long piston is of the "type" "shown" in the Long patent, so the statement in Respondent's brief (p. 67) is again puerile. Nor is it correct for Respondent's counsel to state in their brief (p. 68), "The testimony regarding the use of the Long pistons was adduced by deposition." As a matter of fact, Stellmann testified before the Master after his deposition was read while he sat in court. Murphy, Castor, and Burns testified before the Master and so did Jeffries.*

There is even documentary evidence in 1919 corroborating the witnesses in the evidence of the Long pistons, Exhibits E and F, namely, the **drawing of the Long patent**, which Respondent's counsel admit in their Brief (pp. 62, 64) is "similar to Exhibit F" and "of the type of Exhibit F." There is also **a drawing**, Exhibit BB-1, which bears a 1919 date and which was found in the Franklin records by Respondent's witness Castor (R. 670) and which clearly has the relief in the regions of the bosses. It does not matter that that particular piston was not put into production. Then we have the **license agreement** (R. 1632) which refers to the then pending application of the

*A case that can be made out in all its elements by cross-examination of opposing witnesses is a strong case (Eibel Co. v. Paper Co., 261 U. S., l. c. 53).

Long patent and having also a 1919 date. Then we have the pattern records produced by Gilbert, all as set out in Petitioners' brief (p. 21). Surely the links of the chain connect up more than in any ordinary case, whether a patent case or otherwise.

The fact that the Long pistons scored opposite the webs in 1929, as stated by Respondent's witness Burns (R. 672), does not mean the Long pistons were even impractical. As admitted by Jeffries (R. 1057) that is the point of greatest wear, and Exhibit 1 without the keystone relief wore down at those points. Of course, that is why the keystone relief was added, but that was not done until 1925, as shown in Petitioners' brief (p. 27). In other words, Exhibit 1 without the keystone relief was subject to scoring in 1925, in a water-cooled engine, while the Long piston was not subject to such scoring until four years later, and in an air-cooled engine at that. That explains why Long could not ever be replaced by Exhibit 1 even with a keystone relief.

There is no doubt but that the Long pistons, Exhibits E, F, and G, were proved to have been in existence prior to Jardine's filing date. These pistons are now before the court; they were known to Jeffries since from 1920 on. Jeffries had one of these pistons before him, and he testified not only that the webs were flexible, but "flexible enough." That should settle the matter of the Long commercial pistons being statutory bars against the Jardine patent. Here Respondent's counsel cannot quibble on the amount of flexibility, when Exhibit 1 is a stiff piston, as specifically found by the Master, who not only heard and saw the witnesses, but observed the tests made (Petitioners' brief, page 42).

6. **This Court's Decisions Are Determinative.** This court's decisions construing R. S. 4886 were discussed in Petitioner's brief (p. 45). Respondent's brief (pp. 28,

76, 72), however, cites this court's decisions in Gayler v. Wilder, 51 U. S. 477, 497, and Eames v. Andrews, 122 U. S. 40, 56. An examination of these decisions will, however, show that these very decisions support Petitioners' contentions.

Gayler v. Wilder involved a situation where the prior use of a safe relied upon was sought to be established by **oral** testimony, 51 U. S. 495, **no exemplification** being produced, because "the safe itself had disappeared" (p. 498). There was **no evidence** that any "**test** had been applied to it, and its capability for resisting heat was not known" (p. 497), or that it had **even been used** as "a place for security of papers against fire" (p. 496). Indeed, that was a case which is known in patent law as establishing the principle that something "finally forgotten or abandoned" (pp. 496, 498) is, in Patent Law, one of "**The Lost Arts**" (p. 497). The facts are stated on pages 495-6, and this court says:

> "It does not appear what became of this safe afterwards. And there is nothing in the testimony from which it can be inferred that its mode of construction was known to the person into whose possession it fell, or that any value was attached to it as a place of security for papers against fire; or that it was ever used for that purpose.
>
> "Upon these facts the court instructed the jury, 'that if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald or those claiming under him, if he be an original, though not the first, inventor or discoverer.'"

This court, after quoting from the Act of 1836 that the subject matter of the patent shall have been "not known or used by others before his discovery or invention," says (p. 497):

> "The clause in question qualifies the words before used, and shows that by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public."

This court, however, finally says (p. 498):

> "We do not understand the Circuit Court to have said that the omission of Conner to try the value of his safe by proper tests would deprive it of its priority; nor his omission to bring it into public use. He might have omitted both, and also abandoned its use, and been ignorant of the extent of its value; yet, if it was the same with Fitzgerald's, the latter would not upon such grounds be entitled to a patent, provided Conner's safe and its mode of construction were still in the memory of Conner before they were recalled by Fitzgerald's patent."

From the above it will be seen that the evidence of the Long commercial pistons is not like the evidence in Gayler v. Wilder, but that it is such as this court said in the last part quoted establishes a statutory bar prior to Jardine's filing date of March 11, 1920. **The Exhibits, F, E and G, are before the court; their "mode of construction was known," and their "capacity for resisting heat was known."**

Their "mode of construction was still in the memory of" the witnesses: Petitioners' witnesses Stellman, Venner, Chadwick and Royalty, and even Respondent's witnesses Murphy, Castor and Burns. They were even within the memory of Dr. Jeffries, who was familiar with them in 1920, and testified that in Exhibit F the webs were not only flexing, but, indeed, "that they were flexible enough." They were in use from 1917 to 1929, that is, three years before and nine years after Jardine filed to the extent, in 1920-1929, of 360,000 pistons.

Eames v. Andrews, 122 U. S. 55-56, contains the following statement:

> "It is to be observed that the scientific theory and principle, the application of which is supposed to constitute the invention of Colonel Green, are not set forth either in the original or reissued patents. This feature was commented upon by Mr. Justice Blatchford in Andrews v. Cross, 19 Blatchford 294, 305, as follows: 'It may be that the inventor did not know what the scientific principle was, or that, knowing it, he omitted, from accident or design, to set it forth. That does not vitiate the patent. He sets forth the process or mode of operation which ends in the result, and the means for working out the process or mode of operation. The principle referred to is only the why and the wherefore. That is not required to be set forth. Under section 26 of the act of July 8, 1870, 16 Stat. 201, under which this reissue was granted, the specification contains a description of the invention and of "the manner and process of making, constructing, compounding, and using it," in such terms as to enable any person skilled in the art to which it appertains to make, construct, compound, and use it; and, even regarding the case as one of a machine, the specification explains the principle of the machine, within the meaning of that section, although the scientific or physical principle on which the process acts when the pump is used with the air-tight tube is not explained. An inventor may be ignorant of the scientific principle, or he may think he knows it and yet be uncertain, or he may be confident as to what it is, and others may think differently. All this is immaterial, if by the specification the thing to be done is so set forth that it can be reproduced.'"

In the first place, this decision involves a construction of R. S. 4888 relating to the requirement of what a specification of a patent sought to be enforced must contain as distinguished from R. S. 4886, relating to statutory bars.

This requirement of R. S. 4888 is stated in the above quotation but is not contained in R. S. 4886, because the latter does not require that the "principle of the machine" of a prior known or used or sold device must have been known to anybody, and this court so decided in De Forest Radio v. General Electric Company, cited in Petitioners' Brief (p. 45).

Second, the decision itself, even as applied to R. S. 4888, distinguishes between "the scientific theory and principle," that is, "the scientific principle" and "the process or mode of operation which ends in the result, and the means for working out the process or mode of operation." As this court says, "the principle referred to is only the why and the wherefore. That is not required to be set forth . . . if by the specification the thing to be done is set forth, that it can be reproduced."

This court did not depart from such a construction of R. S. 4888 in its previous decision in this case, because the question of whether the Gulick original application disclosed flexing webs was one of mechanical construction and proportioning, that is, whether "by the specification the thing to be done is so set forth that it can be reproduced." Surely with the Gulick original specification specifying extreme rigidity it could not be said that by the specification the thing to be done was so set forth that laterally flexible webs could be reproduced.

As we have poinfed out above, R. S. 4886 does not have the requirement of R. S. 4888, particularly as to a prior use, because a prior use is a tangible thing, and accordingly "the thing to be done is so set forth that it can be reproduced." The only thing lacking that Respondent relies on, and which the Court of Appeals relied on, is that the scientific explanation of the mode of operation was not understood,* which this court said was unnecessary not

*We have shown that Stellman did understand that in 1916 (Petitioners' Brief, p. 18).

only as to a prior use, but even as to a prior patent or publication,** in order to be a statutory bar under R. S. 4886.

POINT III.

Respondent's Brief, pp. 86-89, distorts our Point III and attempts to present a question of defect of parties-plaintiff which we unsuccessfully raised in the District Court, but waived by deliberately failing to except. Our Point III asserted that Respondent has no right to injunctive relief, it does not challenge Respondent's right to damages. But Respondent's presentation of it as a defect of parties-plaintiff converts it into a challenge of Respondent's right to any and all kinds of relief.

Respondent's intrigue, by way of confessing a defect of parties (for damages as well as injunction) is an attempt to lure the Court into dismissing the Certiorari and thereby in effect AFFIRMING the decision of the Circuit Court of Appeals. The Peters-Bates case (295 U. S. 392) is cited as an authority, but in that case, unlike this, dismissal of the certiorari accomplished dismissal of the suit because the Court of Appeals in that case had ordered the case dismissed. Were this Court to dismiss the certiorari as Respondent urges, Respondent would be left with an undisturbed adjudication by the Court of Appeals, holding the Jardine patent valid and infringed, and holding Respondent entitled to its injunction. Manifestly, this Court should not decide our Point III by dismissing the certiorari.

These cases cannot be dismissed merely because Respondent is not entitled to an injunction.* Respondent, and only Respondent, has a right at law to recover dam-

**See footnote to Petitioners' Brief (p. 46).

*Our suggestion, Brief p. 59, that the bills should be dismissed was an inadvertent overreaching of the established practice of transferring a case to the law side in such circumstances.

ages. Under Title 35, Sec. 67 of the U. S. Code (R. S., Sec. 4919), at law damages may be recovered in the name only of the holder of the legal title. Crown Die & Tool Co. v. Nye Tool & Machine Works, 261 U. S. 24, 40; Independent Wireless Telegragh Co. v. Radio Corporation of America, 269 U. S. 459, 464, 465.

Respondent instituted this proceeding, which is a bill in equity in its nature as well as in its form, and which seeks both legal and equitable relief, but the only remedy open to Respondent was at law. This is a situation parallel to that in Twist v. Prairie Oil & Gas Co., 274 U. S. 684, 692. In that case this Court, because the Circuit Court of Appeals had refused to hear the case on its merits, remanded the case with the suggestion that it might consider the case on the merits as on an equity appeal in the view that at such stage of the proceedings it was desirable to hold that the objection to the equity jurisdiction had been waived. Upon remand the court of appeals in Twist v. Prairie Oil & Gas Co. (C. C. A. 8), 27 F. (2d) 470, 474, accepted the suggestion of this court and proceeded to hear the case on the merits as if it were an equity appeal, upon the theory that the case had progressed so far it was desirable to hold that the objection to the equity jurisdiction had been waived.

In the case Equitable Trust Co. v. Denver & R. G. R. Co. (C. C. A. 2), 250 F. 327, 340, plaintiff brought in equity that which was not an equity action, and thereby obtained injunctive relief, which, when considered in the light of the case actually made, amounted to the use of a writ of injunction as the substantial equivalent of a warrant of attachment. For this there was no warrant. Plaintiff obtained a money judgment for breach of contract. The question of jurisdiction was never raised in the court below; the action was brought to the Court of Appeals by an appeal. The court held that the power of transferring

a case to the proper side of the court existed at any stage of the litigation, and that they could give the direction as well as the district court. The court of appeals, therefore, ordered that the case be remanded with directions to the district court to transfer the same to the law side of the court, and that, so transferred, that the money judgment entered therein be affirmed, further ordering that the several injunctions issued in the course of the litigation should be vacated and set aside. It will be seen that the court there considered the case as one in which a law action was tried by consent without a jury. That action is remarkably parallel to the present one. It was cited with approval by this court in Twist v. Prairie Oil & Gas Co., 274 U. S. 684, 689. It is clear, of course, that these decisions referred to rest upon the provisions of Equity Rules 22 and 23, this court holding in Twist v. Prairie Oil & Gas Co., supra, that under these rules either the trial court or the appellate court might transfer the case to the law side.

In view of the long pendency of the present cases, and the number of times they have been before the courts, this court should decide the case on its merits as if it had been tried at law with jury waived. In the present case, therefore, after a decision on the question of Respondent's right to an injunction, there remains for consideration the award of profits and damages and an accounting therefor, and a dismissal cannot be made until these questions are disposed of.

Respondent in its brief states that the damages in these cases are limited to one dollar each under the final decree (entered before the cases were here previously), but that is not technically correct, because the limitation of damages by decree applied only to the Gulick and Maynard patents, which are not now involved. The decree did not limit damages as to the Jardine patent, but dismissed without prejudice as to it. Furthermore, an award of nominal damages in this case would carry with it the costs or a

part of them, which would be considerable. In addition, the amount involved is not a criterion. A decision of validity and infringement with an award of one dollar is res judicata as to the parties (and in this case extends to Sterling Aluminum Products, Inc.), it is an adjudication of their rights and is important far beyond any damages which may be actually assessed in these cases. The case Webb v. Portland Manufacturing Co., F. Cas. No. 17,322, decided by Justice Story, demonstrates the importance of a decision, and a correct decision even though there is no proof of actual damages. In that case (29 F. Cas. p. 509) it is said that wherever there is a clear violation of a right it is not necessary to show actual damage, that every violation imports damage and if no other be provided the plaintiff is entitled to a verdict for nominal damages. It follows, of course, that a defendant is entitled to have an erroneous judgment against him set aside even though that judgment is for nominal damages.

This case is here on writ of certiorari, and is therefore before this court with a power to decide the case as it was presented to the Circuit Court of Appeals, and any contention properly saved must be examined. This statement is supported by Camp v. Gress, 250 U. S. 308, 318, where it is said, "the contention must be examined, as the whole case is here on writ of certiorari and the objection was properly saved."

In Delk v. St. Louis & S. F. R. Co., 220 U. S. 580, 588, the court said:

> "As the case is here upon certiorari to review the judgment of the circuit court of appeals, this court has the entire record before it, with the power to review the action of that court, as well as direct such disposition of the case as that court might have done when hearing the writ of error sued out for the review of the action of the circuit court."

In summary, plaintiff has brought these suits in equity, but is not entitled to an injunction while being entitled to an award of damages at law, if the Jardine patent is valid and has been infringed. In view especially of the long course of these cases through the courts, if the lack of equity jurisdiction is found to exist, the cases should be treated as if they had been transferred to the law side (with jury waived); and a final disposition of the cases should be made. These cases may not be finally disposed of until the errors properly assigned have been considered, and those errors include questions involving the validity and infringement of the Jardine patent.

The Issue Here Has Not Become Moot, But Is Still Important So Far As The Public Interest Is Concerned.

Respondent's brief discusses this, pages 1-3, of course, with the view of having this Court dismiss the writs of certiorari; and that is also, obviously, the purpose of the discussion under Point III, pages 86-89, which has been answered in this brief under III.

It is stated in Respondent's brief, page 2, that Exhibit 1 "has become obsolete since this suit was tried," and an affidavit of McCoy, one of Respondent's counsel, has been appended to Respondent's brief. This is a rather strange position to take now, when the argument before the Court of Appeals was that the Jardine piston was a solution of the problem, and it is even now so contended later on in Respondent's brief. Respondent certainly did not tell the Court of Appeals that Exhibit 1 had become obsolete. Indeed, Respondent's counsel even now (Brief, p. 10) quote a part of the decision of the Court of Appeals, stating that that court was impressed with the efforts "to completely solve the problem" and that "success is finally attained."

The affidavit of McCoy is incomplete and misleading and shows that McCoy was not familiar with the facts; accordingly, appended to this brief is an affidavit of Horace Duncan, who is fully familiar with the facts. This Court can take judicial notice of the fact that there are many Model A Ford cars still running. Duncan states that the replacements by Ford Motor Company alone are even now from 5,000 to 6,000 pistons per month, manufactured in the Sixth Circuit, to say nothing of a piston manufacturer, also in the Sixth Circuit, cited by Duncan. The fact that Sterling Products Corporation, who supplied Ford Motor Company with the piston castings for the Ford Model A car, and sold machined castings, voluntarily stopped manufacturing the pistons after the first decision of the Court of Appeals, does not change the situation, but shows Sterling's deference for the decisions of the Court of Appeals in suits against Sterling's customers; Sterling being referred to in Respondent's brief as "their patron" (p. 2) and "the sponsor of the Petitioners who is **defending this suit**" (p. 94).

It further appears from the affidavit of Duncan, and from the decision of the Court of Appeals in Sterling Products Corp. v. Cleveland Trust, 94 F. (2) 1019, that Sterling is plaintiff in a suit against Respondent to restrain Respondent from proceeding against other of Sterling customers. It appears further from Duncan's affidavit that there is a counterclaim pending in that suit, at Cleveland, i. e., in the 6th Circuit, for infringement of patents, including the Jardine patent.

The purpose of the effort to prevail upon this court to dismiss the writs of certiorari is, therefore, apparent, namely, to retain the erroneous decision of the Court of Appeals effective against Sterling as a privy, and to interfere with the use of these pistons in the 6th Circuit, in which is concentrated practically all of the automobile manufacturing business of this country.

Aluminum Company of America: Respondent's tirade (brief, pp. 3-4) against our mere mention of the name of Aluminum Company of America, in tracing the title of the Jardine patent and in designating the exclusive licensee, is wholly unjustified. As to whether we attempted "to parade" a name, our brief bespeaks its own acquittal.

"Patent Pools: We find a similar tirade (brief, pp. 5-6) against our mere mention of the fact that the Jardine patent was one of a "pool" of patents, under what this Court referred to as a "pooling agreement" (305 U. S. 49). As to whether we attempted to mention this "by way of attempted derogation," again our brief bespeaks its own acquittal. Despite the opportunities afforded by the Record, we scrupulously avoided mention of sins, which the die-hards might say "influence the issues in this case."

"Sins of the Past": Here we find a discussion in Respondent's brief, pages 6-19, followed by a discussion of what Respondent's counsel denominates "certain fundamental and salient rules of patent law" (brief, pages 20-26). What the purpose of this discussion was we fail to understand, because the questions before this Court involve: Point I, R. S. 4888, relating to claim construction; Point II, R. S. 4886, relating to the requirement of public use as a statutory bar, and Point III, relating to a construction of the injunction statute, 38 U. S. C. A. 384.

The cases cited by Petitioners under Point I were: White v. Dunbar, 119 U. S. 47, decided in 1886; McCarty v. Lehigh Valley, 160 U. S. 110, decided in 1895, and Permutit Co. v. Graver, 284 U. S. 52, decided in 1931.

The case cited by Petitioners in support of Point II, De Forest v. General Electric, 283 U. S. 664, was a recent decision; however, Le Roy v. Tatum, 14 How. 156, relied upon by this Court in that case, was decided in 1852, while

Gayler v. Wilder, 51 U. S. 477, relied upon by Respondent, and which also supports this Court's views in the last case, was decided in 1850.

On the question of what does and what does not constitute invention under R. S. 4886, this Court early developed the legal principles of patent law. In Thompson v. Boisselier, 114 U. S. 1, decided in 1884, this Court said, l. c. 11: "The beneficiary must be an inventor and he must have made a discovery." In Atlantic Works v. Brady, 107 U. S. 192, decided in 1882, this Court said, l. c. 200, that "an indiscriminate creation of exclusive privileges" for matters involving things "which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacture," "tends rather to obstruct than to stimulate invention." In McCain v. Ortmayer, 141 U. S. 419, 428, decided in 1891, this Court pointed out that "the generality of sales" cannot be "made the test of patentability." In Minerals v. Magna Copper, 280 U. S. 400, decided in 1930, cited by the Master (R. 1184), this Court decided that commercial success cannot be attributed to a later patent when an earlier patent, owned by plaintiff, but expired, was broad and comprehensive. In Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 494, decided in 1900, this Court stated that,

> ". . . in determining the question of invention, we must presume the patentee was fully informed of everything which preceded him, whether such were the actual fact or not,"

and that R. S. 4886 is "inexorable" and

> ". . . denies the patent, if the device were known or used by others in this country before his invention."

In Downtown v. Yeager, 108 U. S. 466, decided in 1882, cited in Respondent's brief, page 25, this Court shows, l. c. 474, that the patent in suit must be considered in the light

of the "then well known state of the art"; and that view has been consistently followed by this Court, as will be seen from DeForest Radio v. General Electric, 283 U. S. 664.

It is therefore submitted that this Court has preserved the fundamental and salient rules of patent law, as developed by this Court's decisions for nearly a century.

Page 6 of Respondent's brief, and the footnote is even misleading. The patent in Smith v. Snow, 294 U. S. 1, was held valid and construed broadly so as to make out a case of infringement. Later, in Smith v. Hall, 301 U. S. 216, 232, the claim, as construed by this Court in the previous case, was held invalid over a prior use, and the plaintiff was not permitted to narrow it to avoid invalidity.

"'Smartness' of Petitioners' Brief" (pp. 27-35). Under the above heading, Respondent's counsel proceeds to parade what counsel considers "half truths" in Petitioners' brief. Such is not the case at all, and the eighteen pages do not show that such is a fact. We, therefore, consider it unnecessary to reply thereto.

The Renouncement and Denouncement of Petitioners' now Expired Patents: The Franquist, Ricardo, Schmiedeknecht, Pomeroy, and Hartog patents were discussed in Petitioners' brief, pages 9-17. Here, however, we find a strange proceeding in that Petitioners' own patents are not only denounced but renounced by Respondent (brief, pp. 21, 30, 99, 100), although four of these are in the pool of patents held by Respondent's Trust Estate. Franquist and Schmiedeknecht were in the suit against Sterling's customer, Simmons (R. 101, 2299), and Schmiedeknecht, although held invalid by the Court of Appeals, was in this suit, and the allegation of infringement was of Exhibit 1. The Pomeroy patent (R. 1803) issued to Aluminum Com-

pany and was assigned to Respondent. Hartog issued to Respondent (R. 1797).

The Master (R. 1120) discussed the denouncement of the Franquist patent in these causes. As to Pomeroy, it is now stated (brief, p. 100), "his scheme is fantastic," although that patent describes an aluminum piston with flexing webs. As to Hartog, it is stated (brief, p. 21) that "no piston could" operate in the manner described in the Hartog patent, and, further (p. 30), Respondent's counsel assert "the apparent inoperativeness of Hartog." The high point of Respondent's attack on its own patents, however, is on the Schmiedeknecht patent, previously included in this suit and alleged to be infringed by Exhibit 1. Respondent's brief, page 100, not only states that if Schmiedeknecht were provided with a T-slot it would "fall apart," although Exhibit 1 with the T-slot was alleged to infringe the Schmiedeknecht patent in this cause, but it is even stated, "The corpse and live man analogy . . . applies," the previous statement being, "the comparison is no more than that between a corpse and a living man. . . ."

This is certainly a strange position to take, when up to the very last in the Court of Appeals, Respondent not only relied upon the Schmiedeknecht patent as being valid, and therefore operative and of utility, but as being infringed by Exhibit 1. Although the Schmiedeknecht patent has expired, there has been no surrender of either of the Hartog or Pomeroy patents to the Patent Office, and we wish to assert, without fear of denial, that Respondent has actually filed, and has now pending, an application for a reissue of the Hartog patent.

It is respectfully submitted that the Jardine patent here in suit is invalid, that Petitioners have not infringed, that

Respondent is not entitled to an injunction, and that the decision of the Circuit Court of Appeals for the Sixth Circuit should be reversed.

Respectfully submitted,

JOHN H. BRUNINGA,
JOHN H. SUTHERLAND,
Attorneys for Petitioners.

October 19, 1940.

In the Supreme Court of the United States.

October Term, 1940.

The Schriber-Schroth Company, Petitioner, vs. The Cleveland Trust Company, Chrysler Corporation, Respondents.	No. 9.
The Aberdeen Motor Supply Company, Petitioner, vs. The Cleveland Trust Company, Chrysler Corporation, Respondents.	No. 10.
The F. E. Rowe Sales Co., Petitioner, vs. The Cleveland Trust Company, Chrysler Corporation, Respondents.	No. 11.

AFFIDAVIT OF HORACE DUNCAN.

State of Missouri, } ss.
City of St. Louis. }

Horace Duncan, being duly sworn, deposes and says that he is Secretary and Treasurer of Sterling Aluminum Products, Inc. (formerly called Sterling Products Corporation); that he has been engaged in and is familiar with the aluminum piston business, and that he has been and is in position to estimate the volume of business done by the com-

petitors of Sterling Aluminum Products, Inc. (formerly Sterling Products Corporation).

That he is informed and believes that Ford Motor Company has been, and is still, manufacturing at Detroit, Michigan, aluminum pistons of the construction of Exhibit 1, except having a rib on each web extending downwardly at an angle from each wrist pin boss toward the slotted side of the piston, and that these pistons are sold by Ford dealers for replacement purposes in Ford Model A automobiles in the Sixth Circuit and elsewhere throughout the United States to the extent of about five to six thousand pistons per month. That he is also informed and believes that Thompson Products, Inc., is also manufacturing and selling pistons of that character at Cleveland, Ohio, and is selling the same elsewhere in the United States for replacement in Ford Model A automobiles.

That Sterling Aluminum Products, Inc. (formerly Sterling Products Corporation) has defended the above-entitled causes at its expense and through its counsel to the knowledge of Respondent. That said Sterling Aluminum Products, Inc. (formerly Sterling Products Corporation) is the plaintiff in a cause now pending in the United States District Court at Cleveland, Ohio, in which Respondent has filed a counterclaim for infringement of a number of patents including the Jardine patent No. 1,768,523 because of the manufacture and sale by said Sterling Aluminum Products, Inc. (formerly Sterling Products Corporation) of pistons of the construction of Exhibit 1 in this cause.

That Sterling Aluminum Products, Inc., was informed of the decision of the Circuit Court of Appeals of October 8, 1937, in the above-entitled cause by its counsel, and that thereafter, in deference to the decision of said Court, further manufacture and sale of pistons of the character of Exhibit 1 in this cause were stopped and has not been re-

sumed; and it is not the intention of said Sterling Aluminum Products, Inc. (formerly Sterling Products Corporation) to resume the manufacture and sale of the same until and unless the decision and decree of the Circuit Court of Appeals is reversed by this Court.

Sgd. Horace Duncan.

Sworn to and subscribed to before me this 18 day of October, 1940.

My commission expires Nov. 25, 1942.

Helen S. Bohne,
Notary Public.